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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,289	08/21/2001	Samantha J. Busfield	MBIO1998-061CP1CN1(M)	9334

7590

09/03/2002

Millennium Pharmaceuticals, Inc.
75 Sidney Street
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EXAMINER

MOSHER, MARY

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 09/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,289

Applicant(s)

Busfield

Examiner

Mosher

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- 1-12. Claims 1-7, 12, 18, classified in class 536, subclass 23.5, drawn to:
1. nucleic acid at least 89.5% identical to SEQ ID NO: 1
 2. nucleic acid at least 89.5% identical to SEQ ID NO: 17
 3. nucleic acid at least 58% identical to SEQ ID NO: 29
 4. nucleic acid at least 76% identical to SEQ ID NO: 41
 5. nucleic acid at least 70% identical to SEQ ID NO: 3
 6. nucleic acid at least 70% identical to SEQ ID NO: 19
 7. nucleic acid at least 70% identical to SEQ ID NO: 31
 8. nucleic acid at least 92% identical to SEQ ID NO: 43
 9. nucleic acid encoding SEQ ID NO: 2
 10. nucleic acid encoding SEQ ID NO: 4
 11. nucleic acid encoding SEQ ID NO: 18
 12. nucleic acid encoding SEQ ID NO: 20
- 13-24. Claims 8-10, classified in class 530, subclass 350, drawn to:
13. polypeptide at least 70% identical to product encoded by SEQ ID NO: 3
 14. polypeptide at least 70% identical to product encoded by SEQ ID NO: 19
 15. polypeptide at least 70% identical to product encoded by SEQ ID NO: 31
 16. polypeptide at least 92% identical to product encoded by SEQ ID NO: 43
 17. polypeptide SEQ ID NO: 2
 18. polypeptide SEQ ID NO: 4
 19. polypeptide SEQ ID NO: 18
 20. polypeptide SEQ ID NO: 20
 21. polypeptide SEQ ID NO: 30
 22. polypeptide SEQ ID NO: 32
 23. polypeptide SEQ ID NO: 42
 24. polypeptide SEQ ID NO: 44
- 25-36. Claims 11, 13-15, classified in class 530, subclass 389.1, drawn to compound selectively binding a protein of group 13-24.

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37-48. claims 16-17, classified in class 435, subclass 6, drawn to method for detecting nucleic acid of group 1-12.

49-60. Claims 19-21, classified in class 435, subclass 7.21, drawn to assay to detect compound binding a protein of group 13-24

61-72. Claims 21-22, classified in class 435, subclass 4, drawn to assay to detect compound modulating activity of protein of group 13-24.

Inventions 1-12 are related to inventions 13-24 as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the polypeptides, as claimed, can be made by chemical synthesis or isolation from mammalian cells.

Inventions 1-12 are related to inventions 37-48 as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids, as claimed, can be used to make the encoded proteins.

Inventions 13-24 are related to inventions 49-72 as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

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process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins, as claimed, can be used in a method of inhibiting herpesvirus infection of cells.

Inventions 49-60 and 61-72 are unrelated; although both groups of assays involve the same proteins, they use different active steps to measure different processes, specifically physical association (binding) versus modulation of activity.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP §806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because products 1-12, 13-24, and 25-36 constitute apparently distinct inventions for the following reasons: the polynucleotides of groups 1-12, the polypeptides of groups 13-24, and the binding compounds (antibodies) of groups 25-36 are chemically distinct products, separately classified having separate fields of search. The function and existence of either DNA or protein is not dependent on the existence of the other. The products of each group can be independently synthesized by chemical means. An antibody is encoded by an entirely different DNA than that of the protein which is bound by that antibody, and the primary sequence of the antibody bears no relationship to the sequence of the detected protein. Each of the products have separate, unrelated uses and are not disclosed as being capable of use together. Further, It would place undue burden on the examiner to examine several independent inventions in one application.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent search requirements, restriction for examination purposes as indicated is proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 30, 2002



**MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800**

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